

**REMARKS/ARGUMENTS**

Reconsideration and allowance of this application are respectfully requested.

Currently, claims 1-29 are pending in this application.

**Rejection Under 35 U.S.C. §101:**

Claims 1-29 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Office Action alleges that claims 1-29 are merely directed to an abstract idea which does not result in a practical application, where the practical application produces a concrete, useful and tangible result. Applicant respectfully disagrees. In *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), the Federal Circuit held that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces “a useful, concrete and tangible result” - a final share price momentarily fixed for recording and reporting purposes.

Like the claims in *State Street*, the present claims are directed to a useful, concrete and tangible result. For example, claim 1 requires a method of generating a process plan comprising, *inter alia*, inserting content from a non-generic process element into a generic process plan to generate a process plan on detection of a predetermined pattern.

Claim 1 further requires outputting the generated process plan. Generating the process plan and/or outputting the generated process plan clearly produces “a useful, concrete and tangible result.” Applicant respectfully submits that generating the process plan as claimed alone forms a useful, concrete and tangible result, as would outputting the

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generated process plan (alone). The combination of generating a process plan, and then outputting the generated process plan clearly also forms a useful, concrete and tangible result. Similar comments apply to apparatus claim 10 and its dependents.

Accordingly, Applicant respectfully requests that the rejection of claims 1-29 under 35 U.S.C. §101 be withdrawn.

**Double Patenting Rejection:**

Claims 1-29 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-20 of co-pending application no. 09/739,317 in view of Ernst (U.S. '133). Applicant respectfully traverses this rejection. The present application is an earlier filed parent application of application no. 09/739,317<sup>1</sup>. Concurrent with this Response, Applicant has filed a Response in later-filed application no. 09/739,317 including a Terminal Disclaimer disclaiming a terminal part of any patent granted in the present application. A Terminal Disclaimer has thus been filed in the later-filed application.

MPEP §1490 indicates that if a provisional obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, the Examiner should withdraw the rejection and permit the earlier-filed application to issue as a patent without a Terminal Disclaimer. As noted above, claims 1-29 are in full conformance with 35 U.S.C. §101. Accordingly, Applicant submits that the only rejection remaining in the present application (i.e., the earlier filed application) is the ODP rejection. Since Applicant has filed a Terminal Disclaimer in the later-filed

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<sup>1</sup> Application no. 09/739,317 is a continuation-in-part (CIP) of the present application.

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application, Applicant respectfully requests that the ODP rejection in the present application be withdrawn and permitted to issue as a patent without a Terminal Disclaimer, particularly since Applicant has already filed a Terminal Disclaimer in the later filed application.

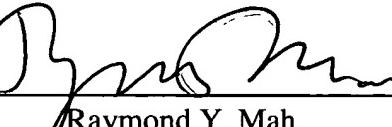
**Conclusion:**

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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